

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-09)

Approved for use through 07/31/2012. OMB 0651-0031  
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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

514413-3869.1

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on \_\_\_\_\_

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Application Number

10/743,792

Filed

12-12-2003

First Named Inventor

Hacker et al.

Art Unit

1612

Examiner

QAZI, Sabiha Naim

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☐ attorney or agent of record.  
Registration number \_\_\_\_\_

☒ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 48,104

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Signature

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Typed or printed name

202-292-1539

Telephone number

14 April 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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## **REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW**

### **I. Status of claims**

Claims 3, 6-9 and 12-22 are pending in this application. There are no amendments after final to be considered. The applicants request reconsideration of the elected species currently under examination and the application of the Ex parte Quadranti decision.

### **II. The combination of the compound of formula (A1) and fenoxaprop (B1.3.3) should have been examined in the Office Action mailed on 14 October 2009**

#### **Basis for clear error**

On page 3 of the final rejection mailed on 14 October 2009, the Examiner stated “Never A1 was elected. **Applicant is not allowed to change the species during prosecution.**” This is incorrect.

MPEP 821.03 states in part that claims added by amendment following action by the examiner, MPEP § 818.01, § 818.02(a), to an invention other than previously claimed, should be treated as indicated by 37 CFR 1.145 (“If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144.”)

However, MPEP 821.03 also states that “[t]he practice [of election by original presentation] set forth in this section is not applicable where a provisional election of a single species was made in accordance with MPEP § 803.02 (Markush claims) and applicant amends the claims such that the elected species is cancelled, or where applicant presents claims that could not have been restricted from the claims drawn to other elected invention had they been presented earlier.”)

In making the requirement for election of species for compounds of group (A) and group (B), the Examiner treated the original claims as though they were Markush claims. At least with respect to claim 18, only the elected species of compound (A1) and fenoxaprop (B1.3.3) is present, i.e. the originally elected species of (A2) and fenoxaprop (B1.3.3) is not encompassed by this claim. Likewise, claim 18 could not have been restricted from the claims drawn to other

elected invention had they been presented earlier because it is one of the other elected inventions presented earlier.

Therefore, at the very least, claim 18 should have been examined after the applicants' filing of the RCE on 7 October 2008.

**III. The reliance on *Ex parte Quadranti* as being supportive of the rejection of claims 3, 6-9 and 12-22 over Giencke, Hoechst, Hirata, Takematsu, Idemitsu and Applicant's disclosure is in error**

**Basis for clear error**

MPEP 2144.04 states that "...if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court."

The applicants agree with the holding of *Ex parte Quadranti* for the limited proposition that it would be obvious to combine a known herbicide with another known herbicide to obtain a third herbicide composition with an expectation of some herbicidal effect (similar to the obviousness of adding a detergent to another detergent holding *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980)("It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art.")(see also citation of *Quadranti* from MPEP 2144.06 – "*Ex parte Quadranti*, 25 USPQ2d 1071 (Bd. Pat. App. & Inter. 1992) (mixture of two known herbicides held *prima facie* obvious").

However, the applicants' invention is not the combination of two known herbicides to provide some level of herbicidal effect, but to produce an **unexpected level of herbicidal effect**, i.e. the combination of (A1) and fenoxaprop (B1.3.3) produces an synergistic level of herbicidal activity **without having to resort to the Colby equation** (see Example 11 of the applicants' specification – the activity against CAPBP (*Capsella bursa-pastoris*) was 100% compared to the expected additive effect of 78% and this activity was accomplished with minimal damage to the winter wheat crop (3%)).

As can be seen from MPEP 2144.06, the *Quadranti* decision was not relied upon as being an indictment on the validity of the Colby equation. To the contrary, the Board of Appeals soon after *Quadranti* validated the appropriateness of relying on the Colby equation.

Support for the applicants' assertion that the Colby equation is appropriate means of determining unexpected herbicidal effects can be found in two decisions by the Board of Patent Appeals and Interferences ("the Board") which were issued after *Quadranti* was published.

Specifically, in the Board's decision from Appeal No. 93-0495 (dated December 10, 1993), the Board found that the data evaluated using the Colby formula appropriate for the purpose of assessing synergism. Page 4, lines 11-21 of the decision, the Board, in discussing *Ex parte Quadranti*, stated:

"The examiner does not deny that appellants achieve results which are superior compared with the calculated response which would have been expected based on the Colby formula. Rather, the examiner's Answer casts aspersions on the Colby model, and goes to great lengths to explain why, in the examiner's view, the Colby model is not reliable for the purpose of assessing synergism. In this regard, the examiner borrows extensively from language found in *Ex parte Quadranti*, 25 USPQ2d 1071 (BPAI 1992), although the examiner does not cite that case in the Answer.

***Each case must be decided on its own facts.*** As stated in *Ex parte Quadranti*, 25 USPQ2d 1071, 1072 (BPAI 1992),

'There is no evidence of record that this approach [based on the Colby formula] is considered to be valid by a significant number of ordinarily skilled workers or authorities in this area of technology.'

That is not the case here. On the contrary, the record contains evidence that the Colby model is an appropriate reference model; that, ***in fact, the most widely used model in the field is the Colby model; and that the use of Colby's model is considered desirable by researchers in this field of endeavor.***" (Page 4, line 11 – page 5, line 10 of the decision)(emphasis added)

Page 5, lines 14-22 of the decision from Appeal No. 93-0495 further states:

"Where, as here, the evidence of record suggests that the Colby method is an appropriate model for the purpose of assessing data for the existence of unobvious results when combination herbicides are at issue, we disagree with the examiner's dismissal of that model as 'not reliable'. ***A person having ordinary skill in the art, armed with Flint et al. article, would have been recognized and understood that the Colby model is reliable, the examiner's position to the contrary, notwithstanding.***" (emphasis added)

Similarly, the Board's decision in Appeal No. 93-3509 (dated November 22, 1993 and referred to in the decision for Appeal No. 93-0495), the Board found that, as recognized in *Quadranti*, facts must be analyzed on a case-by-case basis to determine whether the method or

methods chosen to establish unobvious results clearly and convincingly demonstrate support for an ultimate legal conclusion of nonobviousness.

The negative connotations associated with the Colby equation which were recited in *Quadranti* was not a general proposition regarding use of the Colby equation, but rather, was unique to the factual situation represented by *Quadranti* (“The data at page 22 of the specification illustrate that the addition of various ineffective amounts of Compound IIIb to a slightly effective amount of Compound I produced mixtures having somewhat greater effectiveness than Compound I alone. The absolute effectiveness of all of the mixtures tested with a single exception, was not very great.” *Id.* @ 1075.), i.e. *Quadranti* had one particular examples of unexpected results with a sea of examples which did not show unexpected results or for which such a holding would have been questionable.

In contrast, the applicants did provide a clear example of unexpected results for the combination of (A1) and (B1.3.3) and had no data which would have contradicted or called into question that the example represented unexpected results.

As the factual situation which existed in *Quadranti* does not exist in the factual situation represented by the present application and the holding of *Quadranti* as it relates to the validity of the Colbe equation is inapplicable for the currently claimed invention. Moreover, the factual situation for Appeal No. 93-0495 and 93-3509 are similar to the present application and the Board (and one of ordinary skill in the art) would recognize Colby as an appropriate model for considering data presented in this application.

Therefore, the applicants’ evidence of unexpected results have probative value and should have been considered as evidence when making the determination of obviousness. As the data provides a showing of unexpected results, the evidence of non-obviousness outweighs the evidence of obviousness and the rejection over Giencke, Hoechst, Hirata, Takematsu, Idemitsu and Applicant’s disclosure should have been withdrawn.

#### **IV. Conclusion**

The applicants request correction of these two errors in the final rejection and it is believed that correction of these errors will place the application in condition for allowance or at the very least would simplify and clarify the issues for Appeal.